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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,643	03/10/2004	Ian Peter Marshall	TMG-0004	4207

7590

12/15/2004

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EXAMINER

LACYK, JOHN P

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,643

Applicant(s)

MARSHALL, IAN PETER *CW*

Examiner

John P Lacyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites a handle portion with a contoured means to aid manual gripping thereof. This appears to be incorrect in that, since the handle portion (1) is placed against the body such that the ribbed zone (4) contacts the body then the user would be unable to "grip" the device, therefore making it unclear how the contoured means would aid in gripping.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sekulich.

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Sekulich teaches a device that although states is V-shaped, is considered to be generally U-shaped and if not anticipated then considered obvious to use a V or U shape since they are generally the same shape. The device has a handle portion (11) and a penetrative portion (13) connected together, the tip (27, 28) is curved at its distal end. The handle portion has an inner face with ribs (21, 23) that act as a further stimulate. The shaft portion also has a contoured surface to add additional stimulation. With regard to claim 6, although Sekulich does not specifically disclose the angle between the portions, as see in Figure 2, the angle appears to be in that range. Further to optimum or workable ranges by routine experimentation has been shown to be an obvious expedient to one skilled in the art where the general conditions are disclosed in the prior art, therefore to determine the optimum angle to provide the correct stimulation would have been obvious to one skilled in the art.

6. Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekulich in view of Kontos.

Sekulich discloses the claimed device, as discussed above, except for the use of a means to vibrate, a means to heat and the specific material. Kontos discloses a stimulation device and discloses that it is well known to make the device from an elastomeric material (column 3, lines 5-10), and that it is well known to provide both vibration and heat to such devices to further stimulate the user (18 and 19) using well

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known vibrational means such as a "bullet" which may include a range of selectable modes.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekulich in view of Ritchie et al.

Ritchie et al discloses a stimulation device and teaches that it is known to provide a device which allows for both vaginal and anal insertion together. Therefore a modification of Sekulich such that it includes an anal stimulation means would have been obvious in view of Ritchie et al which shows that this is well known in the art.

8. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekulich in view of Jacobs.

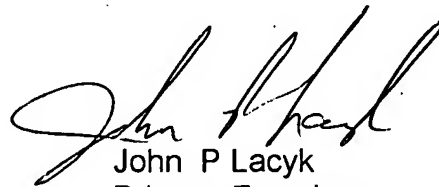
Jacobs discloses a stimulation device and teaches that it is known to provide two stimulation elements connected together by a connecting member (See Figure 19, column 11, lines 55-65). The medial bulge 69 is considered the connecting member that connects the two stimulation elements 52p and 50p and since the device is flexible it is considered to be pivotably mounted to the connecting member. Therefore a modification of Sekulich to provide two stimulating elements to stimulate more than one person at a time would have been obvious in view of the teachings of Jacobs which shows that double-ended devices are well known for use by more than one person at a time.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Lacyk whose telephone number is 571-272-4728.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "John P Lacyk", is positioned above the printed name and title.

John P Lacyk
Primary Examiner
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J.P. Lacyk